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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,710	12/01/2000	Volker Schreiner	Beiersdorf 688-VMM	7950

7590 10/03/2003

Norris McLaughlin & Marcus P.A.
220 East 42nd street
30th Floor
New York, NY 10017

EXAMINER	
WELLS, LAUREN Q	

ART UNIT	PAPER NUMBER
1617	21

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/701,710	SCHREINER ET AL.	
	Examin r	Art Unit	
	Lauren Q Wells	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 August 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-12 and 27-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-12 and 27-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☒ Interview Summary (PTO-413) Paper No(s). 20 .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 5-12 and 27-31 are pending.

The Appeal Brief filed 8/18/03, Paper No. 19, is acknowledged. However, PROSECUTION IS HEREBY REOPENED in light of art that reads on the instant invention. Thus, to avoid abandonment of the application, Applicant is respectfully requested to file a reply under 37 CFR 1.11 since this is a non-final Office Action.

Applicant's arguments with respect to claims 5-12 and 27-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-12 and 27-31 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A method of increasing the synthesis rate of ceramides (specifically ceramides 1, 2 and 3) in the human skin, as recited in instant claims 5, 12 and 28-29 is new matter. While the instant specification teaches increasing the synthesis rate of sphingolipids, increasing the rate of ceramides is not synonymous. While ceramides are one of the reactants in a reaction to make sphingolipids, they are not the only reactants or conditions required to produce the sphingolipids.

Thus, it cannot be said that increasing the rate of sphingolipids inherently increases the synthesis rates of ceramides.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-12 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurose et al. (Pl 9303217).

The instant invention is directed to a method selected from the group of treatment and/or care of dry skin; increasing the synthesis rate of ceramides in human skin; stimulating sphingolipid synthesis; strengthening the lipid barrier of the human skin and combinations thereof for a human in need thereof which comprises applying to the skin of the human a therapeutically effective amount of a composition comprising 0.001-10% of a catechin, a gallic ester of a catechin, or mixtures thereof.

Kurose et al. is directed to extracting flavanoids from tea leaves for use in cosmetics (pages 1-4). The flavanoids extracted from the tea leaves include catechin, epicatechin, epigallocatechin and gallocatechin, inter alia. For the catechin that corresponds to the formula of claim 7, see formula EC at page 3. Kurose et al. teach at page 4, paragraph 2 that the tea Camellia sinensis is a commonly used source for these catechins. The catechins provide various benefits such as skin-softening, skin-moisturizing and emolliency (page 6, paragraphs 4 and 5 and page 7, last paragraph). For topical cosmetic composition containing 0.1-1% of extracts

containing catechins, wherein the catechins comprise 20.3% of the extract or 0.02-0.2% of the composition, see page 8, last paragraph and page 3, second to last paragraph.

Kurose et al. does not explicitly teach application of the compositions containing the catechins to the skin. However, Kurose et al. does teach that the compositions can be provided as cosmetic products for providing moisture conservation and emolliency to the skin, wherein cosmetic composition are applied to the skin. One of ordinary skill in the art would expect from this disclosure to obtain skin moisturization and emolliency by applying these compositions to dry skin.

The claims are directed to a method of applying a composition to the skin of a human. The intended purpose or expected result of application of the composition to skin does not render the claims patentable over the prior art. Terms merely setting forth an intended use for, or a property inherent in, an otherwise old composition does not differentiate the claimed composition from those of the prior art. In re Pearson, 181 USPQ 641. Difference in use cannot render a claimed composition novel. In re Tuominen, 213 USPQ 89. The prior art teaches cosmetic composition containing the instantly claimed components for use as moisturizers to the skin. One of ordinary skill in the art would expect compositions containing the same components to exhibit the same properties, i.e. moisturization, absent evidence to the contrary.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the composition of Kurose et al. to dry skin because of the expectation of achieving moisturization and emolliency.

The claims are additionally directed to a method of increasing the synthesis rate of ceramides 1, 2 and 3 in human skin; and stimulating sphingolipid synthesis; and strengthening

the lipid barrier of the human skin comprising apply to the skin a composition comprising catechin, a gallic ester of a catechin, or mixtures thereof. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently increase the synthesis rate of ceramides in human skin, stimulate sphingolipid synthesis, and strengthen the lipid barrier of the human skin, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

SREENI PADMANABHAN
PRIMARY EXAMINER

9/29/05